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GAU 3672

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Request.
for Reconsideration
E. H. H. H.
8/23/03

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: Roger Sandstrom : Examiner: Jennifer H. Gay
Serial No. 09/806,220 : Group Art Unit: 3672
Filed: May 14, 2001
Title: Thread Coupling For A
Drill String For Percussive
Rock Drilling

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AUG 19 2003

GROUP 3672

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION

Applicant has carefully reviewed the Official Action dated July 3, 2003. For the reasons discussed below, Applicant respectfully requests that the rejection of pending Claims 1 - 4 be reconsidered and withdrawn.

In the Official Action, independent Claim 1 has been rejected under 35 U.S.C Section 103(a) as being obvious over:

1. DE 1170887 in view of Jansson et al (paragraph 2 of the Official Action);

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below.

MARK P. STONE
Reg. No. 27,954

8/15/03
(Date of Deposit)

2. Jansson et al in view of Saunders et al and Puttmann (paragraph 4 of the Official Action);
3. Jansson et al in view of Saunders et al, Puttmann, and Eklof et al (paragraph 6 of Official Action);
4. Larsson in view of Saunders et al and Puttmann (paragraph 8 of Official Action); and
5. Larsson in view of Saunders et al, Puttmann and Eklof et al (paragraph 10 of the Official Action).

Dependent Claims 2 - 4 have each been rejected under 35 U.S.C. Section 103(a) as being obvious over:

1. DE 1170887 in view of Jansson et al and Yao (paragraph 3 of Official Action);
2. Jansson et al in view of Saunders et al, Puttmann, and Yao (paragraph 5 of Official Action); and
3. Jansson et al in view of Saunders et al, Puttmann, Eklof et al, and Yao (paragraph 7 of Official Action);
4. Larsson in view of Saunders et al, Puttmann, and Yao (paragraph 9 of Official Action); and
5. Larsson in view of Saunders et al, Puttmann, Eklof et al, and Yao (paragraph 11 of Official Action).

In each of the rejections of independent Claim 1 as made at paragraphs 2, 4, 6, 8, and 10 of the Official Action, the rejection: 1). first recites the features of independent Claim 1 which the Examiner considers to be disclosed by the primary

applied reference, 2). then discusses the features recited in independent Claim 1 which the Examiner concedes are not disclosed in the primary applied reference but which the Examiner considers to be disclosed by one or more of the secondary applied references, and 3). thereafter concludes that the invention defined by independent Claim 1 would have been considered to be obvious by one of ordinary skill in the art at the time the invention was made.

Essentially, the rejection of independent Claim 1 in each of paragraphs 2, 4, 6, 8, and 10 of the Official Action employs a hindsight reconstruction of independent Claim 1 using Applicant's own disclosure as a guide for selectively combining different portions of different prior art references in the right way so as to reconstruct the rejected claim. However, it is well established that it is improper to reject a claim based upon hindsight reconstruction, even if all features of the claim are disclosed individually in different prior art references. On the contrary, references can properly be combined to reject a claim only if there is a motivation or suggestion in the prior art itself to make the combination. See, for example, Micro-Chemical, Inc. v. Great Plains Chemical Co., Inc., 41 USPQ 2d 1238 (Fed. Cir. 1997). It is improper to reject a claim based upon the use of an Applicant's own disclosure as a guide for selectively combining different portions of the "right references" in the "right way" so as to reconstruct the rejected claim since references can only be combined where a motivation or

suggestion for the combination can be found in the prior art itself. See, for example, In re Fritch, 23 USPQ 2d 1780 (Fed. Cir. 1992). Moreover, the conclusion of obviousness must be supported by actual evidence of record, and not based upon broad conclusory statements of unpatentability by the Patent & Trademark Office. See, for example, In re Dembiczak, 50 USPQ 2d 1614 (Fed. Cir. 1999). Thus, the conclusion that it would be obvious to combine references must be based on actual evidence of record.

Applicant respectfully submits that the rejections of independent Claim 1 made in the Official Action are classic examples of improper hindsight reconstruction. Each of these rejections define different features recited in independent Claim 1, identify different references which are considered to individually disclose the different features, and thereafter conclude, without presenting any evidence of record, that it would be obvious to combine the references to result in the invention defined by independent Claim 1. There is no evidence of record establishing any motivation or suggestion in the prior art references themselves to combine the references in any manner rendering independent Claim 1 obvious, without resort to the use of Applicant's own disclosure as a guide for selectively combining different features of different individual references to reconstruct independent Claim 1. At most, the Official Action establishes that the different features of the invention defined by independent Claim 1 are found in different parts of different

prior art references. However, this, without more (i.e. a suggestion or motivation in the prior art itself to combine the references in any manner rendering independent Claim 1 obvious), is an insufficient basis for rejecting independent Claim 1.

The rejection of dependent Claims 2 - 4 made at paragraphs 3, 5, 7, 9, and 11 of the Official Action, are inappropriate for the same reasons discussed above with respect to independent Claim 1. In fact, each of the rejections of dependent Claims 2 - 4 initially incorporates by reference a prior rejection made to independent Claim 1 (See, for example, the first sentence of each of the rejections raised at paragraphs 3, 5, 7, 9, and 11 which initially cites the same prior art "as applied to claim 1 above", referring to a rejection of independent Claim 1 made in the preceding paragraph.)

For the reasons discussed herein, Applicant respectfully submits that each rejection of each of the pending Claims 1 - 4 is legally insufficient because it relies upon an improper hindsight reconstruction of the claims, and therefore is improper as a matter of law. Applicant therefore respectfully requests that all of the rejections raised against pending Claims 1 - 4 in the outstanding Official Action be reconsidered and withdrawn, and that this application be allowed.

Applicant respectfully submits that all claims are in condition for allowance, and favorable action is respectfully requested.

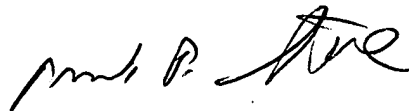
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On June 9, 2003, Applicant filed an Attorney's Change of Correspondence Address. The Official Action dated July 3, 2003 was intended to be mailed to the new address. However, the correct street address of Applicant's attorney is 25 Third Street, 4th Floor, Stamford, CT 06905, and not 25 Third Street, 4th Street, Stamford, CT 06905 as indicated on the cover sheet of the July 3, 2003 Official Action. Applicant requests that the records of the Patent & Trademark Office be revised to correspond to the correct new correspondence address.

Respectfully submitted,



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